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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,659	09/23/1999	HIROYUKI OGINO	35.C13851	4965
5514	7590	03/02/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SCHWARTZ, PAMELA R	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/401,659

Applicant(s)

OGINO ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1-3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively) for reasons of record and for reasons given below. The ratio of alumina hydrate to binder is recited by Yoshino et al. at page 8, lines 51-57 and by Eguchi et al. at page 6, lines 25-28.
2. Claims 1,4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively) as applied to claim 1 above, and further in view of Misuda et al. (5,104,730) or applicants' admissions on page 4 of the specification for reasons of record and for reasons given below.
3. Applicants' arguments filed December 8, 2003 have been fully considered but they are not persuasive. With respect to parallelization degree, applicants argue that the examples of the reference only disclose values up to 3.5, and that coating defects and curling can only be controlled within the range instantly claimed. They argue that these reasons for limiting the parallelization degree are unrecognized in the prior art which gives a different reason for its control, i.e. increasing the circularity of printed dots. First, the teachings of the reference are not limited to the examples. Second, the prior art does not have to have the same reason for limiting a parameter for control of that parameter to be known in the prior art.

Applicants also argue that determination of crystallite size in relation to average particle thickness is not taught or suggested in the prior art. With respect to the examiner's position that these properties will inherently be within claimed ranges

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because preparation techniques of the prior art are the same or similar to those of applicants, applicants submit that orientation of the alumina hydrate that is necessary to prevent curling can be achieved when the average particle thickness is small or when the particle thickness is larger, through the use of a quenching step in production. At certain values, even quenching will not result in orientation. Applicants continue that this is demonstrated in the Examples and Comparative Examples of the application. It appears that applicants are attempting to rely on the result effectivity of the production technique in order to obtain a medium with particle thicknesses that fall within the claimed range and the result effectivity of particle thickness in achieving orientation. The examiner has studied the examples and comparative examples, but has found that the showings have not held enough variables constant for this determination to be made. Applicants are invited to overcome this argument by pointing to the specific examples they believe demonstrate result effectivity of the particle thickness. The examiner was unable to confirm from the examples that at certain particle thicknesses, orientation is achieved without quenching, at others, only with quenching, and still at others, can't be achieved even with quenching. In addition, it is noted that the assignee's EP'904 patent to Eguchi et al., states that "parallelization degree can independently [be] changed by shearing stress on application of the dispersion." Therefore, it would seem that orientation could be achieved by other means besides addition of a quenching step.

It is noted that even if applicants can establish the result effectivity of the particle thickness, the claims are broad enough to read on the reference when quenching is not

required. When the quenching step is not required, it is unclear why production of alumina hydrate by the method disclosed in the prior art would not result in alumina hydrate having the instantly claimed properties.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

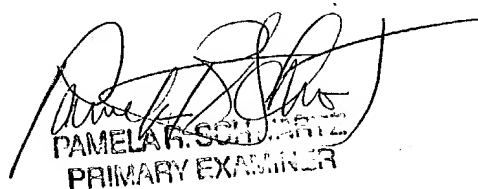
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
February 22, 2004



PAMELA R. SCHWARTZ  
PRIMARY EXAMINER